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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/697,416  | 10/30/2003  | Paul Costain         | Costain-1            | 7210             |
| 7590  | 01/13/2005  |                      | EXAMINER             |                  |
| Donald N. Halgren<br>35 Central St.<br>Manchester, MA 01944 |             |                      | PAYER, HWEI SIU CHOU |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |
|   |             |                      | 3724                 |                  |

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                   |                            |
|------------------------------|-------------------|----------------------------|
| <b>Office Action Summary</b> | Application No.   | Applicant(s)               |
|                              | 10/697,416        | COSTAIN, PAUL<br><i>CM</i> |
|                              | Examiner          | Art Unit                   |
|                              | Hwei-Siu C. Payer | 3724                       |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 5-18 is/are rejected.
- 7) Claim(s) 4 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 October 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## Detailed Action

### Drawings Objection

The drawings are objected to because:

(1) In Fig.4, reference numerals "28" and "20" should read --38-- and --44--, respectively (i.e. the corners of guides 30,32 rather than the corners of base 16).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Objection to the Specification**

The disclosure is objected to because of the following informalities:

- (1) On page 12, line 13, "A elongated" should read --An elongated--.
- (2) On page 13, line 10, "24" should read --26--.
- (3) On page 14, line 1, "18" should read --38--.
- (4) On page 14, line 4, "20" should read --44--.

Appropriate correction is required.

### **Claims Objection**

Claims 4-18 are objected to because of the following informalities:

- (1) In claims 4-9, "cue stick shaper" should read --cue stick tip shaper--.
- (2) In claim 10, line 7, "guide" should read --guides--.
- (3) In claims 16 and 17, "said base" should read --said base member--.

Appropriate correction is required.

### **Claims Rejection - 35 U.S.C. 112, second paragraph**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of claims 13-18 is vague. It is not clear exactly what method step is being claimed therein. To be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure.

**Claims Rejection - 35 U.S.C. 102(b)**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5-7, 10-13 and 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Low (U.S. Patent No. 790,143).

Low's cue stick tip shaper (Figs. 7 and 8) comprises a planar base (6), an arrangement of articulable guides (5,5) for receiving and aligning a cue stick (see Fig.8) received therebetween; a scuff surface (10) arranged on the planar base (6) in alignment with the guides (5,5) for shaping the cue tip, the guides (5,5) each having a groove or a V-shaped notch (see lines 53-62 and Fig.8) thereon for defining a channel for receipt of only a portion of the cue stick, and the guides (5,5) being movably attached to the base (6) and movable with respect to one another to provide an adjustable opening for a cue stick disposed therebetween as claimed.

**Claims Rejection - 35 U.S.C. 103(a)**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Low (U.S. Patent No. 790,143) in view of Willard (U.S. Patent No. 4,594,782).

Low's cue stick tip as set forth shows all the claimed except for the shape of the scuff surface (10), and the scuff surface is not in the form of a replaceable grit insert.

Willard shows a cue tip shaper comprising a scuff surface having a generally hemispherically shaped cutout/depression (12) arranged in an upper surface of a shaper base. The cutout/depression (12) is covered with a layer of grit material (18).

It would have been obvious to one skilled in the art to modify Low by making the flat scuff surface (10) into a hemispherical shape and to cover the scuff surface with a layer of grit material to facilitate shaping the cue tip to a proper curvature as taught by Willard.

3. Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Low (U.S. Patent No. 790,143) and Willard (U.S. Patent No. 4,594,782) as applied to claims 8 and 14 above, and further in view of Kratfel (U.S. Patent No. 4,785,586).

Low's cue tip shaper as modified above shows all the claimed structure except the layer of grit material is not in the form of a "replaceable insert".

However, it is well known in the art to have a cue tip shaper with a shaping insert such that a new insert can be inserted when the old one is worn down as evidenced by Kratfel (see column 3, lines 16-22).

In view of this fact, it would have been obvious to one skilled in the art to further modify Low by making the layer grit material "replaceable" to facilitate replacing of an old shaping insert with a new one as taught by Kratfel.

#### **Indication of Allowable Subject Matter**

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and to overcome the objection as set forth.

#### **Prior Art Citations**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Boyle, Collender, Gottlieb, Olney, Balzano, Garon, Higgs, McCarthy, Bohlig, Bozarth and Zownir et al. are cited as art of interest.

#### **Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-

4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for official communications and 571-273-4511 for proposed amendments.

H Payer  
January 11, 2005



Hwei-Siu Payer  
Primary Examiner